

Applicant: Flickinger et al.  
Serial No. 09/740,051  
Filed: December 18, 2000  
Reply to Non-Final Office Action of July 31, 2006

### **Remarks**

The following remarks are respectfully submitted.

Claims 1-24 stand rejected. Claims 1, 12-14, and 16-17 have been amended, claim 18 has been cancelled and new claim 25 has been added.

The Office has stated two new grounds for the rejections, and these are discussed and addressed by applicant further below. Examiner has taken the position that the declarations and associated evidence submitted under CFR 131 as evidence are insufficient to antedate the Suliman reference and maintains the original prior art rejections based on Suliman. Applicant has submitted a new declaration and associated exhibits constituting additional evidence of invention by applicant prior to Suliman as discussed further below. With these amendments and remarks, applicant believes that all claims are allowable.

### **Rejections under 35 USC 112**

Claims 1-11 and 19-24 have been rejected under 35 USC 112 as allegedly being indefinite for "failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicant traverses the rejections. The Office states that while the claims state "entering data specific to an asset", "it is unclear how the asset data is acquired ... and the independent claims are unclear on these points and thus the claims are confusing and unclear." Applicant respectfully submits that the claims are clear and definite and do distinctly claim the invention. The specification, including the provisional priority document incorporated by reference, contains numerous examples of data being acquired, e.g., at a POS terminal or during an online transaction, etc. Figs. 1-4, Para 21-22 and 26-29 detail some examples, and there are more throughout the specification. There is no substantive requirement of patent law that the applicant limit his claims to a single embodiment of a specific method of entering asset date. The claims, read in light of the disclosure, reasonably apprise one of skill in the art the scope of the invention and are definite. The rejections should be withdrawn and their withdrawal is requested.

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### **Rejections under 35 USC 101**

Claims 12-18 have been rejected under 35 USC 101 as allegedly being directed to non-statutory subject matter. Applicant traverses the rejections and believes the claims are statutory functional description material embodied on a computer readable medium that provide functionality to a computer registration system to accomplish a practical and tangible result. Nevertheless, applicant has amended claims 12-14 and 16-17 and cancelled claim 18 without prejudice and added new claim 25. These claims are believed to be statutory. Withdrawal of these rejections is requested.

### **Antedating the Suliman reference under 37 CFR 1.131**

Applicant has submitted in a prior response, Rule 131 declarations (37 CFR 1.131) from three of the inventors of the present application, said declarations, in compliance with 37 CFR 1.131, aver that the subject matter described and claimed in the present application were conceived prior to the effective date of the cited Suliman reference and by implication the applicant's were diligent in filing the filing of provisional patent application Serial No. 60/172397 on December 17, 1999, only one day after the effective date of the reference. Applicant herewith submits an additional declaration with additional exhibits in order to provide additional factual evidence of both conception and diligence and thus prior invention by the applicant.

### **Conception**

Each of the declarations avers that the conception of the invention of the present application was made prior to Dec 16, 1999, i.e., prior to the effective date of the Suliman reference. Moreover additional corroborative evidence in the form of the printed dated documentation and corresponding electronically date-stamped files of the documentation has been submitted. These documents clearly show corroborating evidence of prior

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conception of the invention of the applicant's. For example, page 5 of the document of Exhibit C (referred to as exhibit A in the first set of declarations), under the section II heading of "E-Registrar", shows the E-registrar concept in a Unified Modeling Language (UML) use case diagram. One of ordinary skill in the art would understand this UML diagram and the use cases it exhibits, including, for instance, a purchaser utilizing his E-Registrar file when purchasing online or offline and the vendor or other 3<sup>rd</sup> party registering the asset or insuring the asset; other use case examples are also apparent. Subsection 3 on page 5 details an example of a company providing an E-registrar files to subscribers for an online or offline (e.g., via a smart credit card) purchases that are used along with the asset data to register the asset. Exhibit D are figures showing various embodiments of the E-registrar system and method of operations. Exhibit D, for instance, shows all the elements of claim 1, i.e., (1) providing an electronic registration database; (2) providing an electronic data file comprising data specific to an entity that purchases or owns assets; (3) extracting the data specific to an entity from the electronic data file and entering it into the registration database; (4) entering data specific to an asset into the registration database; and (5) associating the data specific to the entity and the data specific to the asset, thereby registering the asset for the entity. Thus, conception has been shown prior to the effective date of the reference.

### **Diligence**

Applicant has submitted additional declarations attesting to specific facts pertaining to the preparation and finalization of applicant's provisional patent application during the critical period for which diligence must be shown. Specifically, inventor Flickinger avers in his declaration that he worked daily on preparing the materials for the patent application at least as early as Dec 13, 1999, prior to the beginning of the critical period for which diligence must be shown, continuing to work on the materials each day, until the filing of the application on Dec 17, 1999, the end of the critical period. Inventor Dewolf avers that he commented on the material contained in Exhibit C and transmitted those comments to his fellow inventors on Dec 13, 1999. These averments together with the exhibits submitted, evidencing the advancement of the preparation of the application

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for filing, show due and reasonable diligence during the critical period. Additionally, given the short period of time of the critical period (< 2 days), applicant submits that the showing of the facts are more than sufficient in character and weight to establish conception of the invention and due diligence as required.

37 CFR 1.131(b) states:

...  
(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Examiner is also reminded of the differences between interference practice and that of antedating a reference under 37 CFR 1.131 – as stated in the MPEP (715.07 III):

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

Although applicant has corroborated the assertions made in the declarations by submitting corresponding exhibits, the MPEP (715.07 III) specifically states that averments in declarations are sufficient and do not require additional corroboration:

"Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953)."

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Applicant submits that both prior conception and diligence have been sufficiently demonstrated in compliance with the requirements and intent of 37 CFR 1.131, and respectfully requests that the office acknowledge that the Suliman reference has been removed as prior art and all rejections involving Suliman be withdrawn.

### **Rejections under 35 USC 103**

Applicant believes that the rejections under 35 USC 103 are moot in view of applicant's successful showing of prior invention to Suliman and thus antedating and removing the Suliman reference as prior art, and requests withdrawal of those rejections.

Examiner has restated his rejection from the earlier action, those rejections being substantively identically to those presented in the current action. Notwithstanding that the 103 rejections are now moot, Applicant continues to traverse these rejections, essentially on the same grounds presented in the most recent response (please refer thereto), that the examiner has failed to establish a prima facie case of obviousness in view of the references cited. Portions of Suliman publication, not supported by the priority document, are improperly relied upon, and the proper motivation to combine the references to arrive at applicant's invention is also lacking. The substantive arguments of the applicant will not be repeated here for brevity, but applicant maintains his position and refers examiner to the responses in the earlier amendment.

It is respectfully suggested that for all of these reasons, that the current rejections are totally overcome, and that all of these claims are in condition for allowance. A formal notice of allowance is requested.

Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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Respectfully submitted,

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